

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/541,145

Applicant(s)

SCHMIDT ET AL.

Examiner

Shogo Sasaki

Art Unit

1797

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 August 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 2, 4, 6, 9 and 11-13.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Shogo Sasaki/

/Brian R Gordon/
Primary Examiner, Art Unit 1797

Continuation of 11, does NOT place the application in condition for allowance because: Amendments to the claims are acknowledged. It appears that the amended claim 1 is a combination of previous claims 1, 8 and 10. This combination has been considered in the last office action. The amendments to the claims are entered.

Request for reconsideration filed 8/11/2010 is acknowledged. Applicant's arguments have been fully considered.

Claim 9 is objected because it depends from a cancelled claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. Accordingly, said claim has not been further treated on the merits.

In response to the remarks against the Jones reference on page 4, it is noted that currently presented claim 1 (including the term "miniaturized") do not structurally limit the claimed apparatus to a particular dimension/size. Claims do not structurally require that the device to be limited to a device smaller than certain dimension. Jones' injector or chromatogram (analogues to the instant invention) may dimensionally differ from what is disclosed in instant application. However, the structure of the injector and the general configuration/arrangement of the chromatogram as claimed are disclosed by the Jones references. A skilled artisan, who may be interested in making a small chromatogram and contemplating to utilize a known injector with a larger dimension, would be motivated to alter the dimension of the known injector to accommodate the injector in his/her invention.

In response to page 5, the examiner respectfully asserts that a skilled artisan (in the field of modern chromatography art) would be motivated to look for another method of manufacturing the injector, which is structurally the same but smaller in size, using other available production technique. Claims do not structurally require that the claimed device would have to be made with a specific production technique. In addition, the manner in which a claimed apparatus is made do not distinguish the claimed apparatus from the prior art. Furthermore, Jones teaches covering the injector surface with a Teflon coat (Applicant's polymerized layer includes Teflon.). Jones does not limit said Teflon coat/clad on the surface of his injector to a particular thickness. Applicant's claim also does not limit the Teflon coat/clad to a particular thickness. In response to page 6, second paragraph, as noted in the last office action, how the material for the coat/layer is made or applied (plasma polymerized = method of manufacture), does not impart structural limitations to the apparatus claimed. The recitation "plasma polymerized," which is directed to the manner in which a claimed apparatus is made does not distinguish the claimed apparatus from the prior art. It is further noted that (although this is not part of the last rejection) the plasma polymerized coat is explicitly taught by Lehmann (abstract and discussion sections). Said feature does not appear to be the novel feature of instant invention.

In response to page 6, paragraph 3, the claim recites that the elements are arranged on a circuit board. The phrase "circuit board" does not require said element to be of a particular material or a structure. The limitation only requires a substrate that may be used to provide a circuitry. A silicon chip is a well known material for displacing a small circuitry (such as an imagery CCD sensor). It is noted (for instance in response to page 7, paragraph 2) that claim 1 does not even claim a circuitry connecting elements provided on said board.

In response to page 6, paragraph 4 to page 7, paragraph 2, Lehmann discloses for instance, a flow sensor for evaluating flow fluctuations and a monitor or control unit integrated to the device (section 4). In addition, the micro machined TCD taught by Lehmann will also have to have similar control unit. It is noted that claim 1 does not say that the control unit and the evaluation units are configured for (capable of performing) a particular analytical operation(s); or functionally tied to tie to other elements. The trenches (recess) are present on the silicon substrate of Lehmann.

The examiner maintains his previous position. .